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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,078	03/30/2004	Kazuyuki Tohji	12065-0012	3014
22902	7590	09/20/2007		
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			EXAMINER SHEEHAN, JOHN P	
			ART UNIT 1742	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,078

Applicant(s)

TOHJI, KAZUYUKI

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Previous Rejections

1. The status of the rejections set forth in the Office action mailed March 23, 2007 is as follows.

I. The rejection based on Jeyadevan has been overcome by the declaration submitted October 22, 2004 under 37 CFR 1.132. See the Interview Summary dated July 13, 2007.

II. The provisional obvious double patenting rejection based on Application Serial No. 10/898,287 has been overcome by the Terminal Disclaimer submitted July 16, 2007.

III. The Examiner's comment regarding a potential rejection under 35 U.S.C. 102(e), (f) or (g) has been obviated by applicants' response submitted July 16, 2007.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Interpretation

3. In claims 1 to 3, the subscript Y is recited as "Y represents 0.7 ~ 1.0" (claim 1, line 7). When $Y = 1.0$ then the subscript $1-Y$ equals 0. In view of this, the claims

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encompass embodiments wherein the element Z is not present and the claimed metal composition is a binary metal such as, FePt.

4. Claim 1 recites, "a volumetric ratio of ferromagnetic structure (face-centered tetragonal ratio)...in the range of 10 ~ 100%" (claim 1, lines 9 and 10). The Examiner has interpreted this to mean that the face-centered tetragonal phase structure accounts for 10 to 100% of the volume of the claimed powder.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 3 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Sun (US Patent Application Publication No. 2003/0121364, cited by the Examiner in the Office action mailed March 3, 2007) or Diamon et al. (Diamon '509, PCT Publication No. WO 02/062509, cited by the Examiner in this Office action).

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Sun teaches FePt and CoPt magnetic nanoparticles having a particle size of less than 10 nm and a face centered tetragonal phase structure as recited in applicants' claims (paragraph 0023). Sun also teaches specific example compositions that are encompassed by the instant claims (page 3, right column, line 3 and paragraph 0037, line 4).

NOTE: In the following discussion regarding Diamon '509 the Examiner will refer to sections of US Patent 6,875,253 cited in this Office action and which is the English language equivalent of Diamon '509.

Diamon '509 teaches magnetic particles having a face centered tetragonal phase structure and compositions that are encompassed by the composition recited in the instant claims (column 5, lines 8 to 34). Diamon '509 teaches that the disclosed particles have a particle size of 1 to 50 nm and preferably 1 to 10 nm, which is encompassed by the instant claims (column 6, lines 1 to 5).

The claims and the references differ in that references are silent with respect to the volume percent of the face centered tetragonal phase and the magnetic properties recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the nanoparticles taught by each of the references have compositions and phase structures that are encompassed by the instant claims. In view of this, the powders taught by each of the references would be expected to possess all the same properties as recited in the instant

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claims, including the claimed volumetric ratio of the face centered tetragonal phase and the magnetic properties, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner), see MPEP 2112.01.

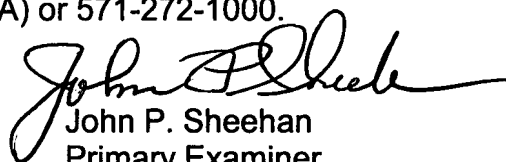
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John P. Sheehan
Primary Examiner
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jps